



FEB 25 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

William L. Androlia
Koda & Androlia
2029 Century Park East, Suite 3850
Los Angeles, California 90067-3024

In re Application of : DECISION ON REQUEST
DETTMANN, et al. :
Application No.: 09/936,087 :
PCT No.: PCT/EP99/01859 : UNDER 37 CFR 1.497(d)
Int. Filing Date: 03 March 2000 :
Priority Date: 06 March 1999 :
Attorney Docket No.: 785A 3140 PCT :
For: SYSTEM FOR WRITING MAGNETIC :
SCALES :

This decision is in response to applicant's "Petition For Correcting Inventorship" filed 21 November 2001. The papers are being treated as a request under 37 CFR 1.497(d).

BACKGROUND

On 03 March 2000, applicant filed international application PCT/EP99/01859, which claimed priority of an earlier application filed 06 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 06 September 2001.

On 06 September 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a translation of the International Application into English; an International Search Report; an International Preliminary Examination Report and a translation of the annexes to International Preliminary Examination Report.

On 29 October 2001, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was also notified of the need to pay the \$65.00 surcharge for providing the oath or declaration later than 30 months from the earliest claimed priority date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 21 November 2001, applicant responded with the present "Petition For Correcting Inventorship"; a combined declaration and power of attorney executed by Fritz DETTMANN, Uwe LOREIT, Carsten MOLLER and Torsten SCHONBACH; an assignment document for recording executed by Fritz DETTMANN, Uwe LOREIT, Carsten MOLLER and Torsten SCHONBACH; a copy of the bibliographic information for the German priority document; a check in the amount of \$65.00 as payment of the surcharge for providing the oath or declaration later than 30 months from the earliest claimed priority date; a check in the amount of \$130.00 as payment of the petition fee and a check in the amount of \$40.00 as payment of the assignment recordation fee.

DISCUSSION

Regarding applicant's reference in the present petition to 37 CFR 1.48(f), it is noted that 37 CFR 1.48 applies only to applications filed under 37 CFR 1.53(b). As detailed further in 37 CFR 1.48(f), 37 CFR 1.497(d) controls in cases concerning the submission of an oath or declaration to enter the national stage under 35 U.S.C. 371.

A request under 37 CFR 1.497(d) [formally, 37 CFR 1.48] to correct an error in naming inventorship requires:

- (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;
- (3) the fee set forth in 37 CFR 1.17(i); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

As Item (3), applicant has provided a check in the amount of \$130.00 as payment of the petition fee. Applicant therefore has satisfied Item (3).

Regarding Item (1), applicant has not provided statements from Carsten MOLLER and Torsten SCHONBACH declaring that the error occurred without any deceptive intention on their part.

As to Item (2), the filed declaration is not in compliance with 37 CFR 1.497 (a)-(b) in that no citizenship has been provided for Carsten MOLLER and Torsten SCHONBACH.

Regarding Item (4), applicant has not provided the written consent of the assignee in compliance with 37 CFR 3.73(b).

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons discussed above, the request under 37 CFR 1.497(d) is **DISMISSED**.

Applicants are hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file any request for reconsideration. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Richard Cole
Legal Examiner
PCT Legal Office



Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459